APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,468	12/04/2001	Paul Chen	2908.P8	2293

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EXAMINER
ARAQUE JR, GERARDO

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		10/000,468	CHEN ET AL.
		Examiner	Art Unit	
		Gerardo Araque Jr.	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>19 September 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-40</u> is/are pending in the application.

    4a) Of the above claim(s) <u>41-47</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-40</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>08 May 2006</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   **Claims 1 – 3, 5, 9, 12 – 15, 18, 23 – 25 and 27 – 35** are rejected under 35

U.S.C. 102(e) as being anticipated by **Chan et al.** (US Patent 6,378,070 B1).

3.   In regard to **claims 1, 9, 14, 18, 24, 27, 29, 31, 33, and 35**, Chan discloses a

method and network system using secure printing where the user uploads a selected

document, identifying the intended recipient for the document, and, inherently, location

information (Column 2 Lines 15 – 19). The location information is inherently uploaded

with the print data information so that the system knows where the print data information

is being uploaded from. This is mostly seen in offices and college campuses where

multiple users from multiple computers are using the same printers. The printer must

receive the location information in order to determine the proper identification

information of the logged-in user requesting the print job. Once the proper identification

information has been identified the printer would then print a cover page containing the

identification information with the correlated print data information.

Chan also discloses that a smart card is used within the system as an option to retrieve the encrypted information (Column 5 Lines 6 – 9). As a result, it must be inherent that when an individual uploads the identification information of the intended recipient the system would, consequently, correlate the identification information with the key information (smart card). Furthermore, a document store is connected to the network, which receives and stores encrypted document files and associated user identities. "The document store 130 also receives requests to forward to specified locations encrypted document files having a specified identity (Column 3 Lines 54 – 61)." Chan also discloses the recipient providing the printing apparatus with a second identifier (identification information) to receive documents from the print server (Column 2 Lines 22 – 26). Once the second identifier is confirmed, which was inputted at the printing apparatus, the print data information is forwarded to the printing apparatus to have it printed (Column 2 Lines 27 – 34).

4.   In regards to **claim 2**, it is inherently included that if multiple computers are connected to the same network some type of identifier must be assigned to the computer, such as the IP Address or Network Address.

5.   In regards to **claim 3**, it is inherently included that when connecting a computer to an existing network the server must assign it an identifier, such as an IP Address or Network Address.

6.   In regard to **claims 5, 12, 23, 25, 28, 30, 32, and 34**, Chan discloses a directory server, which has access to a database of user-specific information, known as user-profiles (Column 3 Lines 35 – 37). "The directory server **120** is arranged to receive from

requesting processes requests for specific information for particular users, and returns

the specific information to the requesting process, whenever possible (Column 3 Lines

37 – 41)." Moreover, Chan discloses that it is, "...necessary for a printer to identify itself

in enough detail that the billing system **150** could allocate billed funds to the printer's

owner (Column 5 Lines 55 – 57)."

7.   In regards to **claim 13**, Chan discloses, "...the document store **130** can be a

modified print spooler or print server process which has access to a large amount of

data storage...(Column 3 Lines 62 – 64)."

8.   In regards to **claim 15**, Chan discloses a method and network system using

secure printing where the user uploads a selected document, identifying the intended

recipient for the document, and, inherently, location information (Column 2 Lines 15 –

19). It is inherently included that when connecting a computer to an existing network

the server must assign it an identifier, such as an IP Address or Network Address.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

10.   **Claims 4 and 36** are rejected under 35 U.S.C. 103(a) as being unpatentable

over **Chan et al.** (US Patent 6,378,070 B1) in view of **Newton** (Newton's Telecom

Dictionary 17th Edition).

11.   In regard to **claims 4 and 36**, it would have been obvious to one of ordinary skill at the time of the invention that if the printing network as disclosed by Chan were to be used in a hotel, a hotel server would be used. The function that is being carried out would be the same regardless of where the server is as is stated by Newton (Newton Page 614 - 615 Server).

12.   **Claims 6 – 8, 10 – 11, 16 – 17, 19, 20, 21 – 22, 26, and 37 – 38** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chan et al.** (US Patent 6,378,070 B1).

13.   In regard to **claims 6 – 8, 10 – 11, 16 – 17, 19, 21 – 22, 26, and 37 – 38**, it would have been obvious to one of ordinary skill at the time of the invention that if the printing network as disclosed by Chan were to be used in a hotel, the location information must comprise hotel information and the server to be used must be a hotel server. The function that is being carried out would be the same regardless of where the printing network, as disclosed by Chan, was located. Regarding the identification information, it is old and well known that various forms of identification can be used depending on the situation. If the case of a hotel it would have been obvious that the identification information would be the room key information. It is old and well known that when staying at a hotel, or the like, information is kept under the room that you stayed at, the credit card used to pay for the stay, and/or the last name and first name of the individual staying and/or paying for the hotel room.

14.   In regards to **claim 20**, it would have been obvious that if an individual was

staying at a hotel and using the hotel's network services user identification must be

given to the individual by the hotel in order to use the hotel's network services.

15.   **Claims 39 – 40** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Chan et al. (US Patent 6,378,070 B1) in view of **Tognazzini** (US Patent 6,195,420 B1).

16.   In regards to **claim 39**, Chan is disclosed above but fails to teach printing billing

information.

Tognazzini, however, does teach a system where a hotel guest receives a

printed copy of the bill. As a result, the Tognazzini discloses that the invention allows a

hotel guest increased flexibility in determining when the bill is prepared and how

disputes over errors or omissions are resolve (Column 1 Lines 61 – 64).

Therefore, it would have been obvious to one of ordinary skill at the time of the

invention in view of the teachings of Tognazzini to modify Chan to have an option of

printing billing information in order to allow a hotel guest increased flexibility in

determining when the bill is prepared and how disputes over errors or omissions are

resolve.

17.   In regards to **claim 40**, Tognazzi discloses that in-room checkout systems are

offered by many hotels in order to permit a guest to view the bill and authorize payment

(Column 1 Lines 11 – 12).

Response to Arguments

18.   Applicant's arguments filed September 19, 2006 have been fully considered but

they are not persuasive.

19.   Objections to claims 25 and 34 are withdrawn.

20.   35 U.S.C. § 112, second paragraph, rejections to claims 4 and 25 are withdrawn.

21.   Regarding the arguments towards the rejections made against claim 1, the

applicant points out that "...claims 7 and 29 are directed to computer process steps and

a computer medium, respectively, and substantially correspond to Claim 1." However,

examiner finds no evidence of computer process steps found in claim 7, but "A method

according to Claim 1, wherein the location information comprises hotel information and

identification information comprises hotel room key information." Examiner believes that

applicant is referring to claim 27. For the purposes of this examination, the examiner

will treat all rejections made for claim 7 to be directed to claim 27 only.

22.   Rejections made towards all dependent claims are maintained due to the lack of

a reply by the applicant in regards to distinctly and specifically point out the supposed

errors in the examiner's action in the prior Office Action (37 CFR 1.111).

Argument regarding Claims 1, 7, and 29

23.   Claim 7 has been discussed above. Applicant points out that Chan fails to

suggest or disclose uploading, via a network, to a printing service provider (PSP), print

data information and location information. However, examiner points out that Col. 3

Lines 54 – 56 of Chan discloses that the document store (PSP) receives and stores

encrypted document files (print data information) and associated user identities.

Applicant further argues that Chan fails to disclose uploading location information.

However, Chan clearly states that the local computer is attached to a network, for

example a network supporting the TCP/IP protocol (Col. 3 Lines 24 – 26, see also Col.

2 Lines 20 – 21). Further still, applicant discloses that the uploaded location information

is the IP address on page 19 of the applicant's remarks. The examiner would like to

point out, again, that because the computer is connected to a TCP/IP protocol it is

inherent that the IP address is uploaded as well. It is old and well known that a

computer is always assigned an IP address when connecting to a network and that an

IP address is a well known means of tracking a plurality of computer connected to a

network. Henceforth, Chan does indeed disclose uploading print data information and

location information.

Applicant further argues that Chan fails to determine identification information

based on the uploaded location information. Once again, examiner points out that it

would be inherent that the system would determine the appropriate identification

information since an IP address is used as tracking means. Moreover, examiner has

also pointed out that determining identification information based on uploaded location

information is an old and well known practice that is practiced at university computer

labs and offices. Further still, Chan discloses a directory server which has access to a

database of user-profiles and is arranged to receive from requesting process requests

for specific information for particular users, and returns the specific information to the

requesting process, in this case location information with identification information of the

user.

Moreover, applicant also argues that Chan fails to correlate the identification

information with the uploaded print data information. Yet Chan discloses that the

document store also receives requests to forward to specified locations encrypted

document files having specified identity (Col. 3 lines 56 – 58) and that it stores the files

with the associated user identities (Col. 3 Lines 56 – 58). Moreover, examiner has also

pointed out that determining identification information based on uploaded location

information is an old and well known practice that is practiced at university computer

labs and offices, in which the printed data would have a cover sheet containing the

users identification information such as the user's name.

Finally, applicant further argues that Chan fails to disclose inputting identification

information at a printing device, transmitting print data information having the correlated

identification information from the PSP, and printing the print data information.

However, Chan again discloses processing means for generating a request for a

document, the request including the identity of the user, transmitting the request to the

print server and receiving a document from the print server, and means for printing the

document for the user (Col. 2 Lines 60 – 61). Moreover, applicant argues that Chan's

use of a smart card as being and unnecessary expense. However, applicant discloses

the use of a room key as a means for identifying a user. The examiner fails to see the

difference of a smart card that contains information regarding a user and a hotel room

key that contains the hotel guest's information. It is old and well known that hotels use

smart cards as a substitute for the traditional metal instrument by which the bolt of a

lock is turned.

Argument regarding Claims 4 and 36

24.   In regards to the arguments made towards claims 4 and 36, applicant traverses

the rejections on grounds that Newton is not prior art because of the lack of the

publication date. Examiner presented the definition of a server found in the 20th Edition

published in 2004. Examiner will still maintain the rejection, but has submitted the

definition of the term "server" found in the 17th Edition of Newton's Telecom Dictionary

published March 2001.

Argument regarding Claims 9 and 14

25.   Applicant argues that Chan fails to disclose the features claimed in claims 9 and

14. In response to applicant's argument that Chan fails to disclose a server apparatus

with a processor and a memory medium capable of storing computer executable

process steps, a recitation of the intended use of the claimed invention must result in a

structural difference between the claimed invention and the prior art in order to

patentably distinguish the claimed invention from the prior art. If the prior art structure is

capable of performing the intended use, then it meets the claim. Further still, Chan also

discloses that the document store and directory server are in communication with each

other for receiving and forwarding necessary information. Nevertheless, examiner has

already discussed that Chan does indeed disclose all of these features.

Argument regarding Claims 18 and 31

26.   Examiner has already discussed all of the features above of claims 1 and 29, but

will discuss the aspect of the invention in which key information is determined in place

of the identification information. As far as the examiner is concerned, the key

information is still a form of identification information, which examiner had discussed in

detail above. Moreover, Chan also discloses the use of a smart card and, as the

examiner has already discussed, it is old and well known that hotels use smart cards as

a substitute for the traditional metal instrument by which the bolt of a lock is turned.

Moreover, as already discussed above, the location information (IP address) is used for

tracking and as a result, it would, inherently, include user ID information. Further still, it

is old and well known that in order to access a network, the user must first have

authorization to use the network, such as User ID and/or Password, which is also a form

of tracking a user.

Argument regarding Claim 35

27.   Examiner has already discussed all of the arguments made by the examiner

above with the exception of uploading hotel guest information. However, the examiner

views hotel guest information as nonfunctional descriptive language. As applicant has

already disclosed on page 8 lines 4 – 5, hotel guest information comprises room key

information, which is another form of identification information that the examiner has

already discussed above. Further still, the applicant has only disclosed a method of

printing over a network and not over a hotel network and, as a result, has never

introduced the notion that the method must be carried out in a hotel. Consequently,

regardless of whether it is hotel guest information, room key information, or user

identification information the form of ID that is used does not change the function of how

the method of printing over a network is carried out.

Argument regarding Claims 24 and 33

28.   Applicant argues that Chan fails to disclose determining whether or not a user is

authorized to use a particular printer. However, Chan discloses that where security is

even more important, it is envisaged that the document store would further incorporate

authentication functionality, which would allow the document store to authenticate either the requesting printer or smart card user. Authentication systems using, for example, digital signatures are well known (Col. 4 Lines 13 – 19).

29.   In conclusion, examiner has maintained all rejections with the exception of claims 4 and 36 due to applicant's traversal of the rejections on grounds that Newton is not prior art. However, examiner has made the necessary corrections.
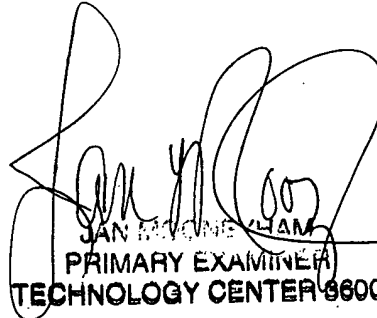
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GA
11/11/06

PRIMARY EXAMINER
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